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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,128	08/16/2001	Yuan Yguerabide	089498-0315	5342

7590 10/03/2003

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EXAMINER

YANG, NELSON C

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 10/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,128

Applicant(s)

YGUERABIDE ET AL.

Examiner

Nelson Yang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-165 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 49-165 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 49-61, 63-66, 68, 71-78, 85-88, drawn to a population comprising gold particles, classified in class 520, subclass 507.
 - II. Claims 49-60, 62, 63, 67, 69, 70, 72-75, 80-88, drawn to a population comprising silver particles, classified in class 520, subclass 501.
 - III. Claims 89-94, 95, 97-107, 112-114, 116-119 drawn to a specifically detectable light scattering gold particle reagent, classified in class 520, subclass 503.
 - IV. Claims 89-94, 96, 97-106, 108, 110-115, 120-124, drawn to a specifically detectable light scattering silver particle reagent, classified in class 520, subclass 505.
 - V. Claims 125-126, drawn to a multiparticle optical signal agent, classified in class 520, subclass 35.
 - VI. Claims 127-134, drawn to a method for making specifically detectable gold particles, classified in class 23, subclass 300.
 - VII. Claims 135-142, drawn to a method for making specifically detectable coated silver particles, classified in class 23, subclass 301.
 - VIII. Claims 143-145, 151-158, drawn to a test kit comprising a plurality of nucleic acid molecules, classified in class 435, subclass 6.

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- IX. Claims 143, 144, 146, 148, 149, 151-158, drawn to a test kit comprising a plurality of antibodies, classified in class 435, subclass 7.1.
- X. Claims 143, 144, 147, 151-158, drawn to a plurality of receptors, classified in class 435, subclass 7.8.
- XI. Claims 143, 144, 150-158, drawn to a plurality of pharmaceutical agents, classified in class 436, subclass 506.
- XII. Claims 159-165, drawn to a test kit comprising a plurality of populations of different distinguishable metal like light scattering particle types, classified in class 423, subclass 21.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IV, and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions I-IV have separate utility such as ornamentation, while invention V has a separate utility such as a magnet. Furthermore, Invention I and III are comprised of gold particles, while II and IV are comprised of silver particles. Inventions I and II are further comprised of additional material on their surfaces that provides chemical stability, while Inventions III and IV have an average diameter between 1 and 500 nm. Invention V is comprised of magnetic or ferro-electrical material. See MPEP § 806.05(d).

3. Inventions I-V, VIII-XII and VI, VII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process

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(MPEP § 806.05(f)). In the instant case the particles of I-V and VIII-XII can be made via electrochemical deposition, while the methods of VI and VII can be used in coating ceramics.

4. Inventions I-IV and VIII-XII are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because any of the groups of I-IV can be used in the kits of VIII-XII. The subcombinations furthermore have separate utility such as ornamentation.

5. Inventions VIII-XII are unrelated, independent and distinct inventions.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. Invention VIII is comprised of nucleic acid molecules, Invention IX is comprised of antibodies, Invention X is comprised of receptors, Invention XI is comprised of pharmaceutical agents, and Invention XII is comprised of plurality of populations of different distinguishable metal light scattering particle types.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the

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search required for one group is not required for others, restriction for examination purposes as indicated is proper.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson Yang whose telephone number is 703-305-4508. The examiner can normally be reached on 8:30-5:00.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V Le can be reached on 703-305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

NY



LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

09/30/03